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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,474	08/17/2001	Kenneth J. Klabunde	RE26499A	7808

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EXAMINER

NGUYEN, CAM N

ART UNIT PAPER NUMBER

1754

DATE MAILED: 05/09/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/933,474

Applicant(s)
Klabunde et al.

Examiner
Cam Nguyen

Art Unit
1754



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 17, 2001 (a reissue application).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5,9
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Reissue Applications

1. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

2. The amendment to the specification in Amendment B (1/28/02) fails to comply with 37 CFR 1.173(b)(1) because it is not underlined in its entirety. The amendment is also not signed. Also, the preliminary Amendment A filed on 8/17/01 adding claims 14-19 must be underlined (see 37 CFR 1.173(b)(2)).

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3. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The error being relied on in the Reissue declaration is too vague and is not directed to the added claims. Specifically, the statement that “the claims are patented are not specified to the target compound and contain limitations not required for patentability of the claimed subject matter” does not accurately reflect the newly added claims, which are directed a method of removing an acid from a gas stream. As set forth in the MPEP 1414 (Section II), the applicant must clearly set forth at least one error.

Claims 1-19 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

If a supplemental declaration was filed that included the error as failure to claim the specific acid from a gas stream target, this rejection would be overcome.

4. Claims 14-19 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball*

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Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The newly added claims 14-19 are drawn to a target species of patented claims 9-13. Newly added claims 14-19 are narrower with respect to the target, i.e. acid from a gas stream, but are also broader with respect to the total pore volume and density of the body. Since both of these broadened limitations were added and argued for allowability in US '249, the applicant is barred from excluding these limitations in these species claims under 35 USC 251.

Claims 14-19 are rejected for failure to include the following limitations:

(a) "said body having a total pore volume which is at least 90% of the total pore volume of said particles prior to said agglomeration thereof"; and

(b) "said body having a density of from about 0.2 to about 2.0 g/cc".

*Note that (a) was added via Amendment B in US '249 in order to place the application in condition for allowance. Also, note Interview Summary of Paper #9 in US '249.

*Note that (b) was added and argued for allowability in Amendment A in US '249.

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Information Disclosure Statement

5. Applicants are requested to provide a copy of PTO-1449 form listing all of the references cited in the patented application (US '249) in response to this Office Action.

Claim Rejections - 35 USC § 112 (Second Paragraph)

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. In claim 14, line 2-4, the correct Markush terminology should be --nanocrystalline metal oxide particles selected from the group consisting of CaO, Ca(OH)₂, and admixture thereof--.
See MPEP § 2173.05(h).

B. Claim 14 recites the limitation "the starting particles" in line 4. There is insufficient antecedent basis for this limitation in the claim. It is unclear as to what starting particles are being referred in the claim.

Citations

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Albers et al. (U.S Pat. 5,928,496), Watson et al. (U.S Pat. 5,059,405), Clemens et al. (U.S Pat. 3,780,500), Wheelock et al. (U.S Pat. 3,974,256), Ghate et al. (U.S Pat. 4,696,680), Dozsa (U.S Pat. 3,793,841), Sell et al. (U.S Pat. 4,161,411), Wijard et al. (U.S Pat. 3,661,554), Mizumo et al. (U.S Pat. 4,833,108), & Fukumoto et al. (U.S Pat. 5,231,063) are cited for related art.

Conclusion

9. Claims 1-19 are pending. Claims 1-19 are rejected. No claims are allowed.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cam Nguyen, whose telephone number is (703) 305-3923. The examiner can normally be reached on M-F from 8:30 am. to 6:00 pm, with alternative Monday off.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (before finals) and (703) 872-9311 (after-final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Nguyen/cnn *CNN*

May 4, 2002


Stanley S. Silverman
Supervisory Patent Examiner
Technology Center 1700